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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/099,823	03/13/2002	James T. Grutta	DP-305782	2707
7590	07/06/2004		EXAMINER	VARGOT, MATHIEU D
Edmund P. Anderson, Esq. Delphi Technologies, Inc. M/C 480.414.420 1450 West Long Lake, 4th Floor Troy, MI 48098			ART UNIT	PAPER NUMBER
			1732	

DATE MAILED: 07/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)
	10/099,823	GRUTTA ET AL.
	Examiner	Art Unit
	Mathieu D. Vargot	1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 28 April 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-36 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

1. Claims 27-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant sets forth different embodiments in paragraphs 43-45 but nowhere in these paragraphs or the entire specification (it was electronically checked) does the term "insulation" occur. Hence, the recitations added into claims 27 and 34 are submitted to be new matter. Applicant needs to point out how paragraphs 43-45 in the specification disclose that the compression is performed "without insulation" or delete this language. No new matter may be inserted into the specification. Note that a **negative** limitation requires **clear support**, and applicant is not entitled to simply add a recitation eliminating something taught in a reference in an attempt to obviate a rejection based on that reference.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11-13 and 24-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent 4-229,209 for reasons of record as set forth in paragraph 2 of the previous action.

3. Claims 27-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Kalnins essentially for reasons of record noting the following.

The aspect of compressing "without insulation" is submitted to be new matter since the term "insulation" never occurs in the specification as filed. Note paragraph 1, supra, concerning negative limitations in claims. Hence, independent claims 27 (and its dependents) and 34 remain anticipated. New claims 35 and 36 call for numerical limitations concerning the pressure applied, and the apparatus of Kalnins is structurally capable of compressing to these levels. Hence, the apparatus itself is anticipated, even though the particular pressure levels may not be explicitly taught.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 and 14-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent 4-229209 in view of Kalnins for reasons of record as set forth in paragraph 4 of the previous action.

5. Applicant's arguments filed April 28, 2004 have been fully considered but they are not persuasive. Comments concerning the rejection against the product claims are simply not persuasive. The Japanese reference softens or melts the thermoplastic composite and then molds the softened or melted material. The molding would allow any number of shapes in Japanese -209 as in the instant. The reinforcement in Japanese -209 would be affected in the same manner by the process of Japanese -209 as in the instant. At any rate, other than attorney conjecture, there is nothing in the instant specification to show what these differences would be, if in fact any actually do

exist. The office does not have the ability to test products and when no apparent difference exists between a product and the prior art, a 102 rejection is proper until applicant rebuts same with persuasive argument or amends the claims around the art. Neither has been done in the instant case. Concerning Kalnins, the exact pressure applied is a process limitation which the structure of the applied reference is inherently capable of performing. The recitation "without insulation" in these claims has already been addressed. The references are submitted to have been properly combined in that one of ordinary skill in the art would have known of methods and means to control composite molding processes. The fact that Kalnins applies a pressure greater than the instant is not a sufficient ground to obviate the rejection, as the exact pressure would certainly have been within the skill level of the art.

6. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mathieu D. Vargot whose telephone number is 571 272-1211. The examiner can normally be reached on Mon-Fri from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni, can be reached on 571 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Vargot
June 28, 2004

M. Vargot
Mathieu D. Vargot
Primary Examiner
Art Unit 1732

6/28/04